

REMARKS

The Applicant respectfully requests further examination and consideration of the claims in view of the above amendments and the arguments set forth fully below. Claims 1-20 were pending in this application. Within the Office Action, Claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,643,981 which issued February 7, 1987, to Card (hereinafter Card). Claims 3-6 and 19 stand rejected under 35 U.S.C. §103(a) as being anticipated by Card in view of U.S. Patent No. 5,636,233 which issued June 3, 1997, to Levinson (hereinafter Levinson). Claim 9 stands rejected under 35 U.S.C. §103(a) as being anticipated by Card in view of U.S. Patent No. 4,909,932 which issued May 20, 1990, to Monnet (hereinafter Monnet). Claims 11-20 are allowed. No claims are withdrawn or cancelled by this response. Accordingly, Claims 1-20 remain pending in this application.

Rejection of Claims 1, 2, 7 and 8 Under 35 U.S.C. § 102(b)

Within the Office Action Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Card. The Applicant respectfully traverses this rejection.

The rejection fails to take into account the teachings of the reference. In response to the previous rejection, the Applicant amended claims 1 and 7 to include the limitation that “a percentage change in the plurality of dimensions is at least 35% of the dimension at the proximal end”. (Please note that a typographical error was introduced in the previous amendment which is corrected above.) The amendment was discounted stating “it would have been obvious to one skilled in the art to modify the vessel dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Arriving at applicant’s claimed percentage of change would require modifying the size of the vessel and not the overall invention itself.” This reasoning fails to take into account the teachings of Card. Card teaches that the “filter material [is] disposed between two layers of porous, *relatively rigid* plastic material.” (Abstract- emphasis added) Card also teaches that “[t]he sample container 11 may be a test tube, the inner walls of which are *preferably slightly internally tapered* to converge toward the closed end 12, but which tube may also be of *uniform internal bore dimensions*.” (Col. 3, lines 60-63 - emphasis added) Because the Card discs are relatively rigid, they are only capable of operating in a vessel which is slightly internally tapered or of uniform dimensions; they are not capable of operating as claimed herein.

A filter assembly made according to the teachings of Card with a sandwich of relatively rigid discs is incapable of operating in a system that would require a percentage change of at least 35%.

Indeed, a construction made according to Card will surely buckle, break or cause the vessel to break. Changing the design of Card to operate in the wholly different manner claimed in claims 1 and 7 would require a complete re-thinking and complete re-design of the filter assembly. A complete re-design is NOT merely "discovering an optimum value of a result". Rather, it requires nonobvious and creative thinking to arrive at the claimed invention. In view of the amendments and these remarks, the Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b). Claims 1 and 7 are amended to include that the dimensions vary at least 35%, which is substantially more than could be achieved with the Card construction using semi rigid layers. For at least these reasons, claims 1 and 7 are allowable over the cited prior art, including Levinson.

Claims 2-6 depend from allowable claim 1. As such, claims 2-6 are also in a condition for allowance. Claims 8-10 depend from allowable claim 7. As such, claims 8-10 are also in a condition for allowance.

Allowed Claims The Applicant gratefully acknowledges that claims 11-20 are in a condition for allowance.

For the reasons given above, the Applicant respectfully submits that the Claims 1-20 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: 1-23-07

By: 

Thomas B. Haverstock
Reg. No. 32,571
Attorney for Applicant